

REMARKS

This is in response to the Office Action that was mailed on September 26, 2006. Applicants gratefully acknowledge the Examiner's indication that this application contains allowable subject matter. Non-elected claims 1-19 and 24-48 are cancelled, without prejudice. Use claims 56-58 are cancelled, without prejudice. The feature of claim 21 is incorporated into claim 20, and claim 21 is accordingly cancelled, without prejudice. The dependency of claim 23 is amended in view of the cancellation of claim 21. A typographical error is corrected in claim 61. New claim 62 is added, based upon claims 59-61. No new matter is introduced by this Amendment. Claims 20, 22, 23, 49-55, and 59-62 are pending in the application.

INFORMATION DISCLOSURE STATEMENT. On page 2 of the Office Action, the Examiner indicates that "The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98". On September 29, 2004, Applicants filed in this application a proper IDS in which the references to be considered by the Examiner were properly listed not only in a Search Report but also on a form PTO/SB/08a/b. The Examiner is respectfully requested to initial the citation of references on the form PTO/SB/08a/b, and to return a copy of the initialed form to Applicants.

Claims 20 and 50-52 were rejected under 35 U.S.C. § 102(b) as being anticipated by WO 02/10137 A2. Claims 20, 50, and 54-61 were rejected under 35 U.S.C. § 102(e) as being anticipated by WO 03/064397 A1. Claim 20 was rejected under 35 U.S.C. § 102(b) as being anticipated by Partridge et al., *Journal of the Chemical Society*, 1964, 3663-3669. Claim 20 was

rejected under 35 U.S.C. § 102(b) as being anticipated by Burmistrov et al., *Khimiya Geterotsiklicheskikh Soedinenii*, 1973, 2, 249-251. Claims 20, 50, 53, 56, 57, 59, and 60 were rejected under 35 U.S.C. § 102(b) as being anticipated by WO 01/53268 A2. Office Action, pages 4-6. Claim 21 was not rejected over any of this prior art, and in fact the Examiner has kindly indicated that claim 21 is allowable. Accordingly, Applicants have amended independent claim 20 to include the feature of allowable claim 21. Accordingly, inasmuch as claim 20 now corresponds to allowable claim 21, each of claims 50-55 and 59-61 depend from allowable claim 20 (formerly claim 21), and claims 56-58 have been cancelled, none of these prior art rejections applies any longer to the claims presently pending in the application.

Claims 56-58 were rejected under 35 U.S.C. § 101 as being non-statutory claims. Office Action, page 7. This ground of rejection has been rendered moot by the cancellation of claims 56-58.

Claims 53-61 were rejected under the first paragraph of 35 U.S.C. § 112 as exceeding the scope of the enabling disclosure. Office Action, pages 7-10. This rejection is based upon alleged lack of predictability in the relevant field and the alleged necessity for undue experimentation to carry out the present invention. The rejection is respectfully traversed. As pointed out in detail on pages 1-8 of the specification, those skilled in the art are aware of the involvement of JNK in neurodegeneration in e.g. Alzheimer's disease and Parkinson's disease. Specification, page 3. On pages 3-7 of the specification, Applicants point to many specific compounds having JNK inhibitory effect. The Examiner's statement of the rejection admits that

those skilled in the art are aware of the use of such compounds “as therapeutic drugs for the treatment of immunological diseases, inflammatory diseases, neurodegenerative diseases, or metabolic diseases”. Office Action, page 9. The Examiner appears to contend, however, that because the extensive relevant prior art summarized on pages 3-7 of the specification are not pyrazoles, persons skilled in the art would not be taught by Applicants’ 694-page long application how to use Applicants’ particular compounds. The Examiner’s logic appears almost to require that the prior art be already familiar with the compounds in question before a specification can be accepted as providing enabling disclosure. Such, of course, is not the law. In any case, the prior art compounds depicted on page 7 of the specification are pyrazoles. It is respectfully submitted that – taking into account the well developed nature of the field of the invention (the use of compounds having JNK inhibitory effect in the treatment of neurodegenerative conditions such as Alzheimer’s disease and Parkinson’s disease) and the high level of ability of persons skilled in the relevant art (PhD-level medical researchers) – the claims herein satisfy the requirements of the first paragraph of 35 U.S.C. § 112.

Objection was raised to claims 51 and 52 as being substantial duplicates of claim 50. Office Action, page 12. Applicants respectfully request reconsideration of this objection. Claim 50 is drawn to a “pharmaceutical composition” comprising a compound and a pharmaceutically acceptable carrier. Claim 51, on the other hand, is drawn to an “inhibitor”. Claim 51 does not recite a carrier. Claim 52 is subgeneric to claim 51. It is accordingly submitted that neither claim 52 nor claim 51 is a duplicate of claim 50.

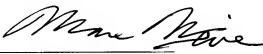
Claims 20, 22, 23, and 50 were rejected on the ground of double patenting over claims 20, 22, 23, and 50 of copending application Serial No. 10/447,948. Inasmuch as this ground of rejection was not applied to claim 21 and because independent claim 20 now corresponds in scope to non-rejected claim 21, this provisional double patenting rejection is obviated by the present Amendment.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher, Registration No. 28,781 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: December 26, 2006

Respectfully submitted,

By 
f G Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant